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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,495	07/25/2006	Daniel Baumgartner	8932-1191-999	3694
51832	7590	04/10/2007		
JONES DAY 222 EAST 41ST STREET NEW YORK, NY 10017-6702			EXAMINER YANG, ANDREW -	
			ART UNIT 3733	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/553,495

Applicant(s)

BAUMGARTNER ET AL.

Examiner

Andrew Yang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/13/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 7-34 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 7-34 have not been further treated on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Stubstad et al. (U.S. Patent No 3867728).

Stubstad et al. discloses a prosthesis for spinal repair having a central axis, a bottom cover plate 12, a top cover plate 11, a central part 15, and a sheathing system that contains the cover plates 11, 12, and the central part 16. Around the central part the sheath is made of a plurality of layers of silicone elastomer that is passed through by a mesh of filaments (Column 7, Lines 40-50). Around the top and bottom cover plates 11, 12 the sheath has the same structure except for the mesh filaments being only partially embedded into the elastomer (Figure 2). Since the filaments are only partially embedded into the

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elastomer, it is considered that it can move relative to the elastomer sheathing body.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickman (U.S. Patent No. 7066960) in view of Stubstad et al. (U.S. Patent No 3867728).

Dickman discloses an intervertebral disc with a central axis having a bottom cover plate 104, a top cover plate 103, each with an external surface extending transversely to the central axis (Figure 10A), a central part 42 with a sheathing that surrounds a fiber system. The sheathing and fiber system both surround the central part 42, is joined to the cover plates 103, 104 (Figures 10A, 10B), and is constructed as a polymer with a bioincorporable fabric that is entirely embedded within the polymer (Figure 3). The polymer is curable (Column 7, Lines 38-40), thus the fabric embedded within the polymer sheathing is not moveable relative to the sheathing body. Dickman fails to disclose the fiber system extending over both cover plates such that it surrounds the central part as well as both cover plates. Stubstad et al. teaches a spinal implant wherein the fiber system 20, 20' is guided over the top and bottom cover plates in order to

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invite tissue ingrowth (Column 8, Lines 6-10). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Dickman with a fiber system that is guided over the surfaces of the top and bottom cover plates in view of Stubstad et al. so that tissue growth could occur at the surface of each cover plate.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stubstad et al. (U.S. Patent No. 3867728).

Stubstad et al. disclose the claimed invention except for the fiber system having a radial thickness of δ and the elastomer sheathing having a radial thickness of d , where the value of $\delta / d * 100$ is in a range between 80% and 350%. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct sheathing system of Stubstad et al. with a fiber thickness of δ and a sheathing thickness of d such that the value of $\delta / d * 100$ is in a range between 80% and 350%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6533817, 6893465, 6626943; U.S. Publication No. 2003/0199984, 2005/0197702, 2003/0135277

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Any inquiry concerning this communication from the examiner should be directed to Andrew Yang whose telephone number is 571-272-3472. The examiner can normally be reached Monday-Friday 7:30 am – 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Eduardo Robert can be reached at 571-272-4719. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private Pair only. For More information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (USA OR CANADA) or 571-272-1000.

A.Y.

4/1/2007


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER